

Patent
Atty. Dkt. No. CARA/0013

REMARKS

The Drawings

The drawings stand objected to under 37 CFR 1.83(a) for failure to show every feature of the invention specified in claims 21-32. Claims 21-32 define various embodiments of a microkeratome that includes a ring in accordance with the present invention. While the microkeratome is not shown in Figs. 1-9C of the present application, a suitable microkeratome is illustrated in U.S. Pat. No. 5,980,543 – the entirety of which the present application incorporates by reference (*Specification* at page 13, lines 10-12).

The incorporation of material by reference in a patent application in order to comply with 35 U.S.C. 112 has been approved by the courts and the USPTO. *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966), and MPEP § 608.01(p). In particular, an application for a patent when filed may incorporate "essential material" necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112), by reference to a U.S. patent. MPEP § 608.01(p). Furthermore, information incorporated by reference "is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed." MPEP § 2163.07(b).

Applicant therefore submits that the objection is not supportable and respectfully requests that it be withdrawn.

The Specification

The specification has been amended to include the description of the kit defined by claim 11, and to mention that embodiments of the inventive ring are suitable for use with microkeratomes having pendular as well as a horizontal cutting paths. No new matter was introduced by these amendments.

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The Claims

In addition to the amendments noted above, claims 8, 18, and 28 were amended to delete the term "circular" from the recited group, and thereby further differentiate the claimed inventions.

A. Section 112 Rejections.

Claims 10-32 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner alleges three deficiencies in the specification: (1) the ring materials were said to be not disclosed; (2) the kit comprising a plurality of rings was said to be not mentioned; and (3) the "means for driving" of claim 21 and the "cutting path" alternatives of claims 31 and 32 were also said to be not cited.

Applicant traverses the first alleged deficiency since the specification clearly mentions the claimed ring materials at page 13, lines 12-14. Reconsideration is respectfully requested.

The second alleged deficiency has been addressed by adding a description of the kit to the specification via the amendment presented above. Reconsideration is respectfully requested.

The third alleged deficiency has been addressed by mentioning in the specification, via the amendment presented above, that embodiments of the inventive ring are suitable for use with microkeratomes having pendular as well as horizontal cutting paths. Reconsideration is respectfully requested.

Claims 6, 7, 16, 17, 26 and 27 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, these claims were said to lack sufficient antecedent basis for the recited phrase "the non-circular." Appropriate correction has been made via the claim amendments presented above. Reconsideration is respectfully requested.

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B. Section 102 Rejections

Claims 1, 3 and 8 – 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,007,553 (“Hellenkamp”). This rejection is respectfully traversed because Hellenkamp fails to teach each of the required elements of the claimed inventions. Claim 1, upon which claims 3 and 8-10 depend, includes the element: “wherein the annular vacuum channel has an *aspherical* ocular globe-engaging *surface* comprising an inferior engaging surface and a superior engaging surface” (emphasis added). This feature promotes a proper seal between the ring and the patient’s eye, particularly at the top aperture region of an astigmatic cornea and the sclera region of an aspherical eye – both of which are difficult to seal using conventional rings. The Examiner has failed to identify any teaching in Hellenkamp of such an aspherical surface. For this reason, these anticipation rejections are not supportable. Reconsideration of these claims is therefore respectfully requested.

Claims 21, 23, 28, 30 and 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,980,543 (“Carriazo”). Claim 21, upon which claims 23, 28, 30 and 31 depend, also contains the element: “wherein the annular vacuum channel has an aspherical ocular globe engaging surface comprising an inferior engaging surface and a superior engaging surface.” Since Carriazo also fails to teach the recited aspherical surface, these anticipation rejections are not supportable. Reconsideration of these claims is therefore respectfully requested.

C. Section 103 Rejections

Claims 11, 13 and 18 – 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,506,198 (“Amano”) in view of Hellenkamp. Claims 11, 13, 18, 19 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hellenkamp in view of Amano. Claim 11, upon which claims 13 and 18-20 depend, also contains the element: “wherein the annular vacuum channel has an aspherical ocular globe-engaging surface comprising an inferior engaging surface and a superior engaging surface.” Since Hellenkamp and Amano fail to teach the recited aspherical surface requirement, and there is no identification of a teaching in the art that bridges this gap, these obviousness rejections are not supportable. Reconsideration of these claims is therefore

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respectfully requested.

Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Carriazo in view of Hellenkamp. Claim 29 depends from claim 21, discussed above, and also contains the aspherical surface requirement. Since Carriazo and Hellenkamp fail to teach this requirement, and there is no identification of a teaching in the art that bridges this gap, these obviousness rejections are not supportable. Reconsideration of these claims is therefore respectfully requested.

The Examiner's indication that claims 2 and 4 – 7 contain allowable subject matter is acknowledged with appreciation. It is respectfully submitted that these claims – particularly claims 4-7 – exemplify various embodiments of the aspherical surface discussed above, and therefore further support a conclusion that the independent claims having the aspherical surface requirement are patentably distinct.

In conclusion, Applicant submits that all remaining claims in the present application are entitled to allowance and such action is earnestly solicited.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/CARA/0013 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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